



02-02-05

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PATENT  
Attorney Docket No. 104.0004-03000  
Customer No. 22882  
Express Mail Label No. ED151082749US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: ) Confirmation No.: 3765  
David F. Meschan )  
Serial No.: 10/735,343 ) Group Art Unit: 3728  
Filed: December 11, 2003 ) Examiner: Ted Kavanaugh  
For: ATHLETIC SHOE WITH )  
IMPROVED HEEL STRUCTURE )

Mail Stop AMENDMENT  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**INFORMATION DISCLOSURE STATEMENT UNDER 37 C.F.R. § 1.97(b)**

Pursuant to 37 C.F.R. §§ 1.56 and 1.97(b), applicant brings to the attention of the Examiner the documents listed on the attached PTO 1449. This Information Disclosure Statement is being filed before the mailing date of a first Office Action on the merits for the above-referenced application.

Applicant respectfully requests that the Examiner consider the listed documents and indicate that they were considered by making appropriate notations on the attached form.

Copies of the following listed non-U.S. documents are enclosed:

1. French Patent No. 533,972, dated March 1922.
2. French Patent No. 958,766, dated March 1950.
3. French Patent No. 2 507 066, dated December 1982.
4. German Patent No. 648 339, dated July 1937.
5. German Patent No. 693 394, dated July 1940.
6. German Patent No. 947 054, dated July 1956.
7. German Patent No. 1 075 012, dated February 1960.
8. German Patent No. 2 742 138, dated March 1979.
9. German Patent No. 2 154 951, dated May 1973.
10. German Patent No. 92 10 113.5, dated November 1992.
11. Great Britain Patent No. 21,594, dated August 1903.
12. Great Britain Patent No. 2 267 424, dated December 1993.
13. Italian Patent No. 331247, dated October 1935.
14. Japanese Patent No. 33-9431, dated October 1958.
15. Japanese Patent No. 1-110301, dated April 1989.
16. Japanese Patent No. 51-81145, dated December 1974.

17. Japanese Patent No. 57-119704, dated July 1982.
18. Japanese Patent No. 57-12006, dated June 1980.
19. Japanese Patent No. 59-137105, dated September 1984.
20. Japanese Patent No. 60-112902, dated July 1985.
21. Japanese Patent No. 61-149503, dated September 1986.
22. Swiss Patent No. 434 029, dated October 1967.
23. WIPO Publication No. 95/20333, dated August 1995.
24. AVIA "Ultra Running" concepts dated December 18, 1986.
25. AVIA "Heel Tension Member" technical drawings dated January 9, 1987.
26. AVIA ARC Shoe (photo; bottom view); sold in 1989.
27. AVIA ARC Shoe (photo; cross section of heel); sold in 1989.
28. AVIA ARC Shoe (photo; bottom view with wave plate); sold in 1989.
29. AVIA ARC Shoe (photo; cross section of heel with wave plate); sold in 1989.
30. Declaration of Jerry D. Stufflefield dated December 4, 2002.
31. TURNTEC 1993 Brochure (TURNTEC 93).
32. TURNTEC 1993 Brochure (TURNTEC 1993).
33. TURNTEC advertisement for "The Predator".
34. *TECHNOLOGY: Cushion of steel puts the spring in high heels*; New Scientist; Vol. 133, No. 1813; 21 March 1992; pp. 1 and 22.
35. Drawing of Mizuno shoe with plate and opening in bottom of shoe dated January 3, 1991.
36. Expert Declaration of Jerry Stufflefield dated October 7, 2002.
37. Report of Keith R. Williams with Exhibits A-G, dated September 8, 2004.

English language abstracts/translations of the non-English documents as indicated on the attached form are enclosed.

Copies of the remaining listed non-U.S. documents were previously submitted in a prior application, Serial No. 09/419,641, filed October 18, 1999, now U.S. Patent No. 6,662,471; Serial No. 09/149,142, filed September 8, 1998, now U.S. Patent No. 5,970,628; or Serial No. 08/542,251, filed October 12, 1995, now U.S. Patent No. 5,806,210, upon which applicant relies for the benefits provided in 35 U.S.C. § 120.

Applicant brings to the Examiner's attention that United States Patent Nos. 5,560,126 (the "126 patent") and 5,970,628 (the "628 patent") (collectively the "Litigation 1 patents") were the subject of litigation in the United States District Court for the Middle District of North Carolina, Greensboro Division, Civil Action No. 1:00 CV 978, hereinafter referred to as Litigation 1.

U.S. Patent Nos. 6,050,002 (the "002 patent"); 6,195,916 (the "916 patent"); 6,324,772 (the "772 patent"); and 6,604,300 (the "300 patent") (collectively the "Litigation 2 patents") were the subject of litigation in the United States District Court for

the Middle District of North Carolina, Greensboro Division, Civil Action No. 1:03CV01044, hereinafter referred to as Litigation 2.

The '300 patent and U.S. Patent No. 6,662,471 (the "471 patent") (collectively the "Litigation 3 patents") are the subject of litigation in the United States District Court for the Middle District of North Carolina, Greensboro Division, Case No. 1:03CV01207, hereinafter referred to as Litigation 3.

In Litigations 1 and 3, the defendants asserted that various references were pertinent to the issue of validity of each of the above-referenced patents under 35 U.S.C. §§ 102 and 103. Applicant notes for the Examiner on the attached Form PTO-1449 in the column for the Examiner's initials the references identified by defendants in Litigation 1 as being allegedly pertinent to the Litigation 1 patents by the designation "Lit. 1." References identified by the defendants in Litigation 3 as being allegedly pertinent to the Litigation 3 patents are identified by the designation "Lit. 3."

The defendants in Litigation 1 raised allegations of inequitable conduct in relation to the procurement of the '126 patent for the failure to disclose the Etonic Dynamic Reaction Plate (technology claimed by U.S. Patent No. 4,878,300) and a drawing showing a Mizuno wave plate with a hole underneath it. The defendants in Litigation 2 raised allegations of inequitable conduct in relation to the procurement of U.S. Patent No. 5,918,384 (a parent of the '002; '916; '772; and '300 patents) and U.S. Patent No. 5,806,210 (a parent of the '628 and '471 patents), alleging that Applicant failed to disclose Turntec's ART technology. The defendants in Litigation 3 raised allegations of inequitable conduct in the procurement of the '384 and '210 patents, alleging that Applicant did not disclose U.S. Patent No. 5,461,800 to Luthi et al.

Litigations 1 and 2 are no longer pending. Litigations 1 and 2 were settled with the defendants in each litigation retracting their assertions of invalidity and inequitable conduct. Discovery documents relating to the aforementioned litigations are available upon request.

This submission does not represent that a search has been made or that no better art exists and does not constitute an admission that each or all of the listed documents are material or constitute "prior art." If the Examiner applies any of the documents as prior art against any claim in the application and applicant determines

that the cited documents do not constitute "prior art" under United States law, applicant reserves the right to present to the office the relevant facts and law regarding the appropriate status of such documents.

Applicant further reserves the right to take appropriate action to establish the patentability of the disclosed invention over the listed documents, should one or more of the documents be applied against the claims of the present application.

If there is any fee due in connection with the filing of this Statement, please charge the fee to our Deposit Account No. 50-1068.

Respectfully submitted,

MARTIN & FERRARO, LLP

Date: February 1, 2005

By: 

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Sir:

**CERTIFICATE OF MAILING VIA U.S. EXPRESS MAIL**

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Date of Deposit: February 1, 2005

I hereby certify that:

1. Information Disclosure Statement Under 37 C.F.R. § 1.97(b)
2. Form PTO-1449
3. 37 documents
4. Self-addressed return postcard receipt

are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service with sufficient postage under 37 C.F.R. § 1.10 on the date indicated above and are addressed to:

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P.O. Box 1450  
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Date: February 1, 2005

  
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OMB 0651-0031  
Express Mail Label No. ED151082749US

Substitute for FORM PTO-1449		Attorney Docket Number 104.0004-03000	Customer No. 22882		
INFORMATION DISCLOSURE CITATION IN AN APPLICATION		Applicant David F. Meschan	Application Number 10/735,343		
(Use several sheets if necessary) Sheet <u>1</u> of <u>3</u>		Filing Date December 11, 2003	Group Art Unit 3728	Examiner J. Kavanaugh	
<b>U.S. PATENT DOCUMENTS</b>					
EXAMINER INITIAL	DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS
Lit. 3	6,662,471	12/2003	Meschan		
	6,321,465	11/2001	Bonk et al.		
	5,979,078	11/1999	McLaughlin		
	5,685,090	11/1997	Tawney et al.		
	5,595,004	1/1997	Lyden et al.		
	5,575,088	11/1996	Allen et al.		
Lit. 3	5,560,126	10/1996	Meschan et al.		
Lit. 3	5,461,800	10/1995	Luthi et al.		
	5,363,570	11/1994	Allen et al.		
Lit. 3	5,325,611	7/1994	Dyer et al.		
Lit. 1	5,319,866	6/1994	Foley et al.		
	5,297,349	3/1994	Kilgore		
	5,279,051	1/1994	Whatley		
	5,220,737	6/1993	Edington		
Lit. 1 & 3	5,185,943	2/1993	Tong et al.		
Lit. 3	5,152,081	10/1992	Hallenbeck et al.		
	5,083,361	1/1992	Rudy		
Lit. 3	5,070,629	12/1991	Graham et al.		
	5,068,981	12/1991	Jung		
Lit. 1	5,052,130	10/1991	Barry et al.		
Lit. 1	5,014,449	5/1991	Richard et al.		
Lit. 3	4,879,821	11/1989	Graham et al.		
Lit. 1 & 3	4,878,300	11/1989	Bogaty		
	4,843,741	7/1989	Yung-Mao		
Lit. 3	4,815,221	3/1989	Diaz		
Lit. 1 & 3	4,785,557	11/1988	Kelley et al.		
Lit. 1 & 3	4,709,489	12/1987	Welter		
Lit. 1 & 3	4,638,575	1/1987	Illustrato		
	4,610,099	9/1986	Signori		
	4,592,153	6/1986	Jacinto		
Lit. 3	4,566,206	1/1986	Weber		
Lit. 1	4,561,195	12/1985	Onoda et al.		

	4,492,046	1/1985	Kosova			
Lit. 1 & 3	4,342,158	8/1982	McMahon et al.			
Lit. 1	4,322,895	4/1982	Hockerson			
Lit. 3	4,317,293	3/1982	Sigle et al.			
	4,224,750	9/1980	Delport			
	4,198,037	4/1980	Anderson			
	3,432,158	8/1982	McMahon et al.			
Lit. 1 & 3	3,085,359	4/1963	Rubens			
Lit. 1 & 3	3,083,478	4/1963	Rakus			
Lit. 1	2,707,341	5/1955	Romano			
Lit. 1 & 3	2,628,439	2/1953	Rochlin			
Lit. 1 & 3	2,500,302	3/1950	Vicente			
	2,464,251	3/1949	Moody			
Lit. 3	2,403,442	7/1946	Klaus			
Lit. 3	2,348,300	5/1944	Klaus			
Lit. 1	1,721,714	7/1929	Ross			
Lit. 3	674,636	5/1901	Priestman			
Lit. 1 & 3	485,813	11/1892	Hooper			

#### FOREIGN PATENT DOCUMENTS

	DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION (YES/NO)
	533 972	3/1922	France			Abstract Only
	958,766	3/1950	France			Yes
	2 507 066	12/1982	France			Abstract Only
Lit. 3	92 10 113.5	11/1992	Germany			Yes
	2 742 138	3/1979	Germany			Abstract Only
	2 154 951	5/1973	Germany			Abstract Only
Lit. 3	1 075 012	2/1960	Germany			Yes
	947 054	7/1956	Germany			Partial
	693 394	7/1940	Germany			Partial
	648 339	7/1937	Germany			Partial
	21 594	8/1903	Great Britain			N/A
Lit. 3	2 267 424	12/1993	Great Britain			
	331247	10/1935	Italy			Partial
Lit. 1	5-18965	5/1993	Japan			Partial
	1-110301	4/1989	Japan			Abstract Only
	61-149503	9/1986	Japan			Partial
	60-112902	7/1985	Japan			Partial
	59-137105	9/1984	Japan			Partial
	57-119704	7/1982	Japan			Partial
	57-12006	6/1980	Japan			Partial
	51-81145	12/1974	Japan			Partial

	33-9431	10/1958	Japan			Partial
	434 029	10/1967	Switzerland			Partial
Lit. 3	WO 95/20333	8/1995	WIPO			N/A

**OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)**

Lit. 1	AVIA "Ultra Running" concepts dated December 18, 1986.
Lit. 1	AVIA "Heel Tension Member" technical drawings dated January 9, 1987.
Lit. 1	AVIA ARC Shoe (photo; bottom view); sold in 1989.
Lit. 1	AVIA ARC Shoe (photo; cross section of heel); sold in 1989.
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Lit. 1	AVIA ARC Shoe (photo; cross section of heel with wave plate); sold in 1989.
Lit. 1	AVIA 1989 Catalog excerpt.
Lit. 1	AVIA Fall 1991 Footwear Catalog.
	Declaration of Jerry D. Subblefield dated December 4, 2002.
Lit. 1	Drawing of Mizuno shoe with plate and opening in bottom of shoe dated January 3, 1991
	Expert Declaration of: Jerry D. Stubblefield dated October 7, 2002.
Lit. 1	Etonic Spring Sport Shoe Catalog; page 4; (1993)
Lit. 1	Mizuno Sport Shoe Catalog (1986).
Lit. 1	Mizuno 1985 Sports Shoe catalog excerpts (MIZJP 02524-02531).
Lit. 1	Mizuno 1986 Sports Shoe catalog excerpts (MIZJP 02532-02537).
Lit. 1	Mizuno 1987 Athletic Footwear catalog excerpts (MIZJP 02538-02546).
Lit. 1	Mizuno 1988 Athletic Footwear catalog excerpts (MIZJP 02547-02549).
Lit. 1	Mizuno 1991 All Line-Up catalog excerpts (MIZJP 02550-02556).
Lit. 1	Mizuno 1992 Run-Bird All Line-Up catalog excerpts (MIZJP 02557-02559).
Lit. 1	Mizuno 1993 All-Line-Up catalog excerpts (MIZJP 02560-02564).
	Report of Keith R. Williams with Exhibits A-G, dated September 8, 2004.
Lit. 1	Runner's World 1989 Spring Shoe Survey and ETONIC and AVIA advertisements (MIZ 135893 – MIZ 135902).
	TURNTEC 1993 Brochure (TURNTEC 93).
	TURNTEC 1993 Brochure (TURNTEC 1993).
	TURNTEC advertisement for "The Predator".
Lit. 3	"TECHNOLOGY: Cushion of steel puts the spring in high heels"; New Scientist; Vol. 133, No. 1813; 21 March 1992; pp. 1 and 22.

<b>EXAMINER</b>	<b>DATE CONSIDERED</b>
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EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP § 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to the applicant.